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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,964	04/07/2006	Eiji Kato	81864.0070	8731
26/021 7590 01/22/2009 HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
SHEEHAN, JOHN P				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,964

Applicant(s)

KATO ET AL.

Examiner

John P. Sheehan

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD/IC)
- Paper No(s)/Mail Date 7/11/05 & 10/19/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1 to 9, in the reply filed on November 5, 2008 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed July 11, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Applicants have not provided a complete copy of each of the listed Japanese Patent Publications, but rather applicants have provided only the abstract of each of the listed documents. The submission of only the abstract of the underlying foreign language document is not sufficient for the record to reflect the submission of the entire document. The abstracts that were submitted have been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. On page 3 of 4 (entitled "Amendments to the Drawings") of the Preliminary Amendment submitted July 11, 2005 applicants state that a replacement drawing for Figure 8 is included in the Preliminary Amendment. Applicants are advised that the Examiner did not receive said replacement drawing.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 to 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. The definitions of the terms "X" and "Y" are not clear. For example, "X" is defined as,

"wherein X represents (the weight ratio of heavy rare earth elements)/(the weight ratio of all the rare earth elements) for a given number of said main phase grains in said sintered body;" (claim 1, line 13 to 16, emphasis added by the Examiner)

In this definition, X is defined as the ratio of 2 ratios, that is, X is defined as the ratio of the weight ratio of heavy rare earth elements to the weight ratio of all the rare earth elements. However, neither of these 2 ratios used in this definition of X,

- i) the weight ratio of heavy rare earth elements
- ii) the weight ratio of all the rare earth elements

is defined in the claims or in the specification. In like manner, the meaning of the term "Y" is not clear.

II. Claims 1 to 9 are indefinite in view of the use of the term, "system" as used in the phrase "R-T-B system rare earth permanent magnet" (claim 1 to 9, line 1, emphasis added by the Examiner). The Examiner considers the term, "system" to be akin to the term, "type", MPEP 2173.05(b) (under heading, (e) Type) and therefore indefinite.

Allowable Subject Matter

7. Claims 1 to 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 1 to 9, none of the references alone or in combination teach or suggest a sintered rare earth permanent magnet comprising main phase $R_2T_{14}B$ grains and a grain boundary phase having a higher rare earth content than the main phase wherein the sintered rare earth permanent magnet satisfies the formulas:

$$AVE(X)/Y = 0.8 \text{ to } 1.0; \text{ and}$$

$$(X/Y)_{\max}/(X/Y)_{\min} = 2.0 \text{ to } 13.0,$$

nor the result of achieving the combination of both a high residual magnetic flux density and high coercivity when the requirements of these formulas are met as demonstrated in Figures 5, 16, 22, 27 and 31 of the applicants' specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JPS